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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,274	06/21/2000	Christopher John Wraight	AP32556-071838	6407

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NEW YORK, NY 10112

EXAMINER

LACOURCIERE, KAREN A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/598,274

Applicant(s)

WRAIGHT ET AL.

Examiner

Karen A. Lacourciere

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45, 46, 49, 50, 52-60, 64, 65, 67-77, 79, 80 and 82-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45, 46, 49, 50, 64, 65, 76, and 77 is/are allowed.
- 6) ☒ Claim(s) 52-60, 67-75, 79, 80 and 82-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

The prior rejections of record are withdrawn in response to Applicant's arguments and amendments filed 01-16-2004, however, new rejections are set forth herein. The support for the particular modifications claimed, as added in claims 45, 64 and 76 and claims dependent thereon, would be inherent to the disclosure, which includes modifications wherein the length and sequence compositions would be unchanged relative to the unmodified oligonucleotide. Additionally, cancellation of SEQ ID NO:10 obviates the rejection of record over Werther et al.

Claim Objections

Claims 52-60, 67-75, 79, 80, and 82-87 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Each of claims 52-60, 67-75, 79, 80, and 82-87 depend from claims 45, 64 and 76, which explicitly limit the type of modification to the claimed nucleic acid molecule does not change the length or base composition of the specifically claimed nucleic acid sequences, however, each of claims 52-60, 67-75, 79, 80, and 82-87 include the limitation wherein the nucleic acid molecule is a modification of a specific sequence and, therefore, does not further limit the parent claim, but actually increases the scope to any type of modification to the specifically claimed sequence. Therefore, these claims do not further limit the parent claim.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 52-60, 67-75, 79, 80, and 82-87 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 52-60, 67-75, 79, 80, and 82-87 are rejected due to the recitation "a modification thereof". It is unclear what types of modifications and the number of modifications can be made to the specifically claimed sequences and still be a nucleic acid which is a modification of the claimed sequence, rather than an entirely different molecule.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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Claims 79 is rejected under 35 U.S.C. 102(b) as being anticipated by Baserga et al.(U.S. Patent No. 5,643,788).

Baserga et al. disclose an 18 mer nucleic acid comprising the instantly claimed SEQ ID NO:12 (SEQ ID NO:4 of Baserga et al.), which is a modification of SEQ ID NO:12, capable of inhibiting IGF-I mediated cell proliferation, and further disclose this nucleic acid in a pharmaceutically acceptable carrier. Therefore, Baserga et al. anticipates claim 76.

Claim 79 is rejected under 35 U.S.C. 102(b) as being anticipated by Delafontaine.

Delafontaine discloses a 20-mer DNA modification of SEQ ID NO:12 (SEQ ID NO:1 of Delafontaine). Delafontaine further discloses this oligonucleotide in a pharmaceutically acceptable carrier. The nucleic acid disclosed by Delafontaine would be expected to inherently be capable of inhibiting IGF-I mediated cell proliferation. Therefore, Delafontaine anticipates claim 79.

Claim 79 is rejected under 35 U.S.C. 102(b) as being anticipated by Low et al. (WO 98/22579).

Low et al. (WO 98/22579) disclose an 18 mer DNA modification of the instantly claimed SEQ ID NO: 12 (SEQ ID NO:1 of Low et al.). Low et al. further disclose their oligonucleotide in a pharmaceutically acceptable carrier. The nucleic acid disclosed by Low et al. would inherently be capable of inhibiting IGF-I mediated cell proliferation. Therefore, Low et al. anticipates claim 79.

Response to Arguments

Applicant's arguments filed 01-16-2004 have been fully considered but they are not persuasive. Applicant argues in their response to the rejection of

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record under 35 USC 112, first paragraph, that "chemical modification" would be understood by the skilled artisan as a modification that does not change the length and sequence of a nucleotide sequence, and therefore, would only be limited to such types of modifications.

This has been considered in light of the rejection under 35 USC 112, second paragraph and 35 USC 102 set forth herein, however, modifications to nucleic acid sequences in the art are not limited to the types of modifications discussed by applicant, nor are modifications defined to limit the modifications to those which do not change the sequence or length of the nucleic acid and, therefore, the recitation broadly of "modification thereof" is not limited to modifications which maintain the length and sequence of a nucleic acid.

Allowable Subject Matter

Claims 45, 46, 49, 50, 64, 65, 76, and 77 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A. Lacourciere whose telephone number is (571) 272-0759. The examiner can normally be reached on Monday-Thursday 7:00-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on (571) 272-0760.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karen A. Lacourciere
April 5, 2004


KAREN A. LACOURCIERE, PH.D.
PRIMARY EXAMINER